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PITNEY BOWES INC.
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EXAMINER

JABR, FADEY S

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* FREDRICK W. RYAN, JR.,
9 BRADLEY R. HAMMELL, and
10 ANUJA S. KETAN
11

12
13 Appeal 2009-013417
14 Application 10/707,510
15 Technology Center 3600
16

17
18 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
19 JOSEPH A. FISCHETTI, *Administrative Patent Judges*.
20 FETTING, *Administrative Patent Judge*

21 DECISION ON APPEAL¹

22

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

1 STATEMENT OF THE CASE

2 Fredrick W. Ryan, Bradley R. Hammell, and Anuja S. Ketan
3 (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of
4 claims 1, 3-12, 14, and 16-23, the only claims pending in the application on
5 appeal.

6 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
7 (2002).

8 SUMMARY OF DECISION²

9 We AFFIRM-IN-PART.

10 THE INVENTION

11 The Appellants invented systems and methods for processing refund
12 requests in a postage system. Specification ¶ 0020.

13 An understanding of the invention can be derived from a reading of
14 exemplary claim 1, which is reproduced below [bracketed matter and some
15 paragraphing added].

16 1. A method for processing a postage refund request for a mail
17 piece comprising:

18 [1] receiving a refund request including a tracking identifier
19 from a user system;

² Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed March 9, 2009) and the Examiner's Answer ("Ans.," mailed April 20, 2009), and Final Rejection ("Final Rej.," mailed October 9, 2008).

[2] processing and paying the refund request substantially immediately after receiving the request and before review of the refund request to determine validity;

[3] then determining if the refund request is valid;

[4] if the refund request is not valid, initiating a refund error process, wherein,

[a] the determination of whether the refund request is valid includes determining whether the tracking identifier has been observed in a mail stream; and

[b] monitoring the tracking identifier after processing the refund request in order to determine if the mail piece is used after a refund payment.

THE REJECTIONS

The Examiner relies upon the following prior art:

Gullo et al. US 2004/0044586 A1 Mar. 4, 2004

Montgomery et al. US 2003/0101147 A1 May 29, 2003

Claim 1 stands rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention.

Claims 1, 3-12, 14, and 16-23 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gullo and Montgomery.

ISSUES

The issue of whether the Examiner erred in rejecting claim 1 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement turns on whether the Appellants were in possession of the feature of paying a refund request after receiving it and subsequent to payment determining whether the request is valid.

The issue of whether the Examiner erred in rejecting claim 1 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention turns on whether a person with ordinary skill in the art would have understood what was being claimed by the terms “substantially” immediately.

The issue of whether the Examiner erred in rejecting claims 1, 3-12, 14, and 16-23 under 35 U.S.C. § 103(a) as unpatentable over Gullo and Montgomery turns on whether Gullo and Montgomery describe paying a refund after receiving it and later determine whether the request is valid.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Appellants’ Disclosure

01. Tracking information is used in determining whether to honor a refund request in a preferred embodiment. Specification ¶ 0092.

In an alternative embodiment, a refund request may be honored

1 and data collected for later use to detect any fraud. Specification ¶
2 0092.

3 *Facts Related to the Prior Art*

4 *Gullo*

5 02. Gullo is directed to a method of processing refunds online,
6 including processing refunds for unused postage. Gullo ¶ 0002.
7 Gullo is concerned with automatically tracking label/indicia use,
8 approve refunds, and monitor fraud. Gullo ¶ 0010.

9 03. Gullo describes the method begins with an Information Based
10 Indicia (IBI) postage that is sold to a user and the user affixes this
11 IBI on to the shipping label on the article to be mailed. Gullo ¶
12 0015. A unique tracking number or label number is associated
13 with the IBI such that the IBI can be identified. Gullo ¶ 0015. A
14 user seeking a refund will provide sufficient information to verify
15 the identity of the user and the tracking/label number for an IBI as
16 evidence of the purchase. Gullo ¶'s 0015-0016. The provided
17 information is further processed to determine whether the
18 tracking/label number has been previously voided or refunded.
19 Gullo ¶ 0019. If the customer does not meet the fraud-prevention
20 criteria, the refund request is denied. Gullo ¶ 0019. If the criteria
21 are satisfied, the refund request is queued for a designated scan
22 time period. Gullo ¶ 0020. Upon satisfaction of the scan period,
23 the request is approved, the account is credited, and the customer
24 is notified via email. Gullo ¶ 0020.

04. Security steps are taken to prevent fraud or misuses of the refund method by tracking users who repeatedly submit improper refund requests. Gullo ¶ 0021. Repeat abusers may have their postage printing capabilities suspended or may be reported to a body capable of taking further action. Gullo ¶ 0021. A provision can be made where a user repays the amount they owe to have their account reactivated. Gullo ¶ 0021.

Montgomery

05. Montgomery is directed to electronic postage metering systems and personal computer (PC) based postage systems. Montgomery ¶ 0001. Montgomery is concerned with the fraudulent use of copies of valid postage indicia. Montgomery ¶ 0020.

06. Montgomery describes a postage system that provides a refund for unused postage. Montgomery ¶ 0169. A postage refund inquiry consists of a unique tracking ID and a delivery status. Montgomery ¶ 0169. A refund inquiry can be accessed by either determining the transaction information meets specific criteria or an audit review of all of the transactions for the account. Montgomery ¶'s 0170 and 0175. Specific criteria for duplicate transactions include (1) two or more transactions, (2) none of the transactions have been refunded in the past, (3) issued for the same account, (4) issued on the same day, (5) issued to the same destination, (6) issued for the same service class, (7) issued for the same postage amount, and (8) each transaction has an associated unique tracking ID. Montgomery ¶ 0170. The account

1 administrator selects the refund option and the user's account will
2 be credited. Montgomery ¶ 0170. Furthermore, the refunded
3 postage transaction is entered into a database for recording status
4 data such that the delivery status can be checked for six months.
5 Montgomery ¶'s 0170 and 0188.

6 ANALYSIS

7 *Claim 1 rejected under 35 U.S.C. § 112, first paragraph, for failing to*
8 *comply with the written description requirement*

9 The Examiner found that the specification fails to describe the feature of
10 “paying the refund request substantially immediately after receiving the
11 request and before review of the refund request to determine validity” in
12 such a manner to reasonable convey to a person with ordinary skill in the art
13 that the Appellants had possession of the invention. Ans. 3. The Appellants
14 contend that Fig. 8 and paragraph 0092 of the specification describe the
15 invention sufficiently and therefore the claimed invention complies with the
16 written description requirement. App. Br. 11. We agree with the
17 Appellants. The Appellants must convey to those skilled in the art that, as of
18 the filing date sought, he or she was in possession of the invention. *Vas-*
19 *Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). The
20 Specification describes that in an alternative embodiment, a refund request
21 may be honored and tracking information can be collected to later detect any
22 fraud. FF 01. This description in the Specification is sufficient to convey
23 that the Appellants were in possession of the invention. A person with
24 ordinary skill in the art would have understood that the Appellants possessed
25 an invention that allows for immediate refund payment and the later

1 detection of fraud, as recited in claim 1. As such, claim 1 satisfies the
2 written description requirement of claim 1.

3
4 *Claim 1 rejected under 35 U.S.C. § 112, second paragraph, as being*
5 *indefinite for failing to particularly point out and distinctly claim the subject*
6 *matter which the Appellants regard as the invention*

7 The Examiner found that the term “substantially” is vague and indefinite
8 and therefore claim 1 is unclear. Ans. 3-4. The Appellants contend that a
9 person with ordinary skill in the art would read the sequence of Fig. 8 and
10 understand the term “substantially” immediately to refer to the time required
11 in the process. App. Br. 11-12. We agree with the Appellants. The test for
12 definiteness under 35 U.S.C. § 112, second paragraph, is whether “those
13 skilled in the art would understand what is claimed when the claim is read in
14 light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*,
15 806 F.2d 1565, 1576 (Fed. Cir. 1986)(citations omitted). Claim 1 is
16 requiring that the processing and paying of the refined request is
17 “substantially” immediately after receiving the request. A person with
18 ordinary skill in the art would have understood the scope of how much time
19 can elapse in order to be “substantially” immediately. As such, we do not
20 find the scope of claim 1 to be indefinite.

21
22 *Claims 1, 3-12, 14, and 16-23 rejected under 35 U.S.C. § 103(a) as*
23 *unpatentable over Gullo and Montgomery*

24 The Appellants contend that Gullo and Montgomery fail to describe
25 limitations [2] and [3] of claim 1. App. Br. 14. We agree with the

1 Appellants. Limitation [2] requires processing and paying a refund request
2 before the refund is reviewed for its validity. Limitation [3] further requires
3 determining whether the refund request is valid.

4 Gullo describes a postage refund method where a user submits a
5 tracking/label number in order to receive a refund. FF 03. Gullo explicitly
6 describes that upon receipt of the tracking/label number the system
7 processes the received information to determine whether the number has
8 been previously refunded or voided. FF 03. Gullo further describes that the
9 refund request is put in a queue for a scan period in order to determine the
10 validity of the request. FF 03. As such, Gullo fails to describe paying the
11 refund request substantially immediately after receiving the request and
12 before review of the refund request to determine its validity.

13 Montgomery also describes a postage refund method where a user
14 submits a refund request. FF 06. Montgomery describes that a refund
15 inquiry can be analyzed against specific criteria or an audit review of all
16 postage transactions can be performed. FF 06. In either processing method,
17 the refund inquiry is reviewed for validating before a refund is granted. The
18 Examiner argues that Montgomery describes that the end user's account will
19 be credited for the misprint and the transaction will be flagged as refunded in
20 the postage database. Ans. 15. However, these refunding steps are done
21 subsequent to a review and determination that the refund inquiry is valid.
22 FF 06.

23 As such, Gullo and Montgomery fail to describes limitations [3] and [4]
24 of claim 1. Dependant claims 3-12, 14, and 16-19 inherit the same
25 limitations by reference and therefore Gullo and Montgomery fail to

1 describe these claims for the same reasons. Since this issue is dispositive as
2 to the rejection against these claims, we need not reach the remaining
3 arguments in support of claims 3-12, 14, and 16-19.

4 The Appellants additionally contend that Gullo and Montgomery fail to
5 describe a tracking code lifetime period associated with the tracking
6 identifier, as per claim 20. App. Br. 15. We disagree with the Appellants.
7 Gullo describes queuing a refund request for a designated period of time to
8 determine if a scan event occurs. FF 03. Montgomery further describes
9 tracking refund inquiries by monitoring the tracking information for six
10 months to determine whether a mail piece associated with any refunded
11 postage has been received. FF 06. The Appellants fail to provide any
12 further rationale to distinguish this claimed feature from the prior art. As
13 such, both Gullo and Montgomery describe this feature of claim 20.

14 The Appellants further contend that Gullo and Montgomery fail to
15 describe or suggest the feature that the refund request corresponds to a prior
16 postage dispense operation test with regard to association with the user and
17 such variable test periods, as per claim 21. App. Br. 15-16. We disagree
18 with the Appellants. Gullo describes that the IBI may be purchased or
19 dispensed to the user and the user affixes the IBI on to the mailing piece. FF
20 03. As such, Gullo describes the refund request corresponds to a postage
21 dispense operation. As noted by the Examiner, Gullo further describes
22 queuing the refund request for a designated period of time that can be varied
23 and a person with ordinary skill in the art would have recognized that
24 different classes of mail will have variable delivery dates. Ans. 10-11, 17
25 and FF 03. Therefore, Gullo suggests variable test periods. The Appellants
26 fail to provide any further rationale to distinguish this claimed feature from

1 the prior art. As such, the combination of Gullo and Montgomery describes
2 claim 21.

3 The Appellants also contend that Gullo and Montgomery fail to describe
4 assessing a fine if a mail piece is used after a refund request, as per claims
5 22-23. App. Br. 16. We disagree with the Appellants. Gullo describes
6 taking security steps to prevent fraud or misuse of the refund method. FF
7 04. Gullo describes that repeat abusers may have their postage printing
8 capabilities suspended or be reported for further action. FF 04. Gullo also
9 describes a provision allowing a user to repay an amount owed. FF 04. A
10 fine encompasses any limitation of privilege or additional performance in
11 response to an abuse or misuse of a feature. These security measures,
12 including requiring a user to pay back an amount owed, are a fine. As such,
13 the combination of Gullo and Montgomery describe claims 22-23.

14
15 **CONCLUSIONS OF LAW**

16 The Examiner erred in rejecting claim 1 under 35 U.S.C. § 112, first
17 paragraph, for failing to comply with the written description requirement.

18 The Examiner erred in rejecting claim 1 under 35 U.S.C. § 112, second
19 paragraph, as failing to particularly point out and distinctly claim the subject
20 matter which the Appellants regard as the invention.

21 The Examiner erred in rejecting claims 1, 3-12, 14, and 16-19 under 35
22 U.S.C. § 103(a) as unpatentable over Gullo and Montgomery.

23 The Examiner did not err in rejecting claims 20-23 under 35 U.S.C.
24 § 103(a) as unpatentable over Gullo and Montgomery.

1

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DECISION

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To summarize, our decision is as follows.

4

- The rejection of claim 1 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement is not sustained.

5

6

7

- The rejection of claim 1 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which the Appellants regard as the invention is not sustained.

8

9

10

- The rejection of claims 1, 3-12, 14, and 16-19 under 35 U.S.C. § 103(a) as unpatentable over Gullo and Montgomery is not sustained.

11

12

- The rejection of claims 20-23 under 35 U.S.C. § 103(a) as unpatentable over Gullo and Montgomery is sustained.

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14

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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AFFIRMED-IN-PART

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22 mev

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Appeal 2009-013417
Application 10/707,510

1 PITNEY BOWES INC.
2 INTELLECTUAL PROPERTY & TECH. LAW DEPT.
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